

REMARKS

Claims 1-20 are now pending in the application. Claims 1, 2, and 10 have been amended. Claims 12-20 are new. The new and amended claims are supported by the application as filed and do not present new subject matter. Applicants respectfully request reconsideration and withdrawal of the rejections in view of the claim amendments and remarks contained herein.

TELEPHONIC INTERVIEW

Applicants' representative, Brent G. Seitz, thanks Examiner Baisa for the courtesies extended during the telephonic interview of November 18, 2010. During the interview, differences between Applicants' invention and the cited art were discussed. ***The Examiner agreed that*** the cited art fails to disclose or suggest: (1) the claimed electrically conductive layer between a primary and secondary winding, as substantially set forth in dependent Claim 2, new dependent Claim 13, and new independent Claims 14 and 18; and (2) the electrically conductive layer including an intermediate layer that is different than an inner and outer layer, as substantially set forth in new dependent Claim 12 and new independent Claims 14 and 18.

The Examiner agreed to participate in another interview with Applicants' representative prior to issuance of a new Office Action, if the claims as set forth herein are not in a condition for allowance. Applicants thank the Examiner for this opportunity to expedite prosecution. Applicants are filing herewith an Applicants' Initiated Interview Request Form for such an interview and request that the Examiner contact the undersigned to schedule the interview at the Examiner's convenience.

REJECTION UNDER 35 U.S.C. § 112

Claims 4, 8, and 9 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because the claims allegedly contain subject matter that was not described in the specification in a way as to reasonably convey to one skilled in the relevant art that the inventor had possession of the claimed invention at the time the application was filed. This rejection is respectfully traversed.

In particular, the Office Action asserts that the following claim features are not supported by the specification: “at least one of the partial layers [of the electrically conductive layer] is formed as a foil” (Claim 4); “the foil includes an arrangement of openings at regular intervals in particular in the form of a lattice net” (Claim 8); and “electrically conductive layer is roll formed from a flat material, such that an overlapping of the material occurs at the adjoinment area” (Claim 9). All of the objected to claim features were present in the claims as *originally filed*, which constitute part of the specification. *In re Dossel*, 42 U.S.P.Q.2d 1881, 1884 (Fed. Cir. 1997) (“the specification of a patent consists of, and contains, both a written description of the invention and the claims”).

The first paragraph of 35 U.S.C. § 112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same....

Thus, “[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can

reasonably conclude that the inventor had possession of the claimed invention.” M.P.E.P. § 2163(I). “It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification.” *Id.* “There is a ***strong presumption*** that an adequate written description of the claimed invention is present when the application is filed.” M.P.E.P. § 2163(I)(A) (emphasis added). “[**T**he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.” *Id.* (*citing In re Wertheim*, 541 F.2d 257, 263 (C.C.P.A. 1976) (emphasis added)).

The Office Action failed to establish a *prima facie* Section 112 rejection because it did not present evidence or reasons why one skilled in the art would not have been able to make and use the invention based on the application as filed as a whole, ***including the original claims.*** Thus, the Office Action failed to rebut the “strong presumption” that claim features present in claims as originally filed are supported by the specification.

The claim features cited by the Office Action, such as “foil,” “lattice net,” and a “layer is roll formed,” are features that would have been readily understood by a person skilled in the art of automotive engineering and automobile spark plugs, for example, at the time of filing so as to enable such a person to make and use the invention. The Section 112 rejection is therefore improper. Applicants respectfully request reconsideration and withdrawal of this Section 112 rejection of Claims 4, 8, and 9.

CLAIM OBJECTIONS

Claim 10 is objected to because “Applicant[s] [have] to make clear if ‘the layer’ recited in line 5 of Claim 10 is the same as ‘the electrically conductive layer’ in line 3 and because “there is insufficient antecedent basis for...’the contact.’” Applicants have amended Claim 10 to clarify that the second recitation of “layer” refers to the “electrically conductive layer” and to delete “the” prior to “contact” to address the antecedent basis objection. Applicants respectfully request reconsideration and withdrawal of the objections of Claim 10.

REJECTION UNDER 35 U.S.C. § 103

Claims 1, 5, 6, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Skinner et al. (U.S. Pat. No. 6,360,706) in view of Moga et al. (U.S. Pat. No. 6,463,918). Claims 2, 3, and 11 stand rejected under 35 U.S.C. § 103 as unpatentable over Skinner in view of Moga and further in view of Park (U.S. Pat. No. 7,123,121). Claims 4, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Skinner in view of Moga and further in view of Takahara et al. (U.S. Pat. No. 4,586,015). These rejections are respectfully traversed.

Independent Claim 1

Independent Claim 1 recites, in part and with reference to Figures 2a, 2b, and 3 for example, “an electrically conductive, substantially cylinder formed layer [16] with mechanical dampening properties is located ***within an annular space defined by the outermost winding*** [1] of the two windings; and ... is formed as a ***sandwich*** structure [Figure 3] comprising at least two partial layers [16a, 16b] with a intermediate layer [17] with mechanical dampening characteristics lying therebetween” (emphasis added).

The Skinner reference appears to disclose a spark plug that includes a winding 64 and a pencil coil shield 18. The shield 18 is at an outermost portion of the spark plug and not positioned within an annular space defined by the winding 64. The shield 18 has a single layer made of a single material; it is not formed as a sandwich structure with an intermediate dampening layer between an inner and outer layer. Skinner fails to disclose or suggest that the shield includes dampening characteristics.

The Moga reference appears to disclose, with reference to Figures 1 and 2, a spark plug generally including a primary winding 24 and a secondary winding 30. An epoxy potting material, which provides electrical insulation, is positioned between the primary winding 24 and a winding spool 28 for the secondary winding 30. The Moga reference thus fails to disclose or suggest, and in fact teaches away from, an electrically conductive material having a sandwich structure located between the primary and secondary windings.

Both the Skinner and Moga references fail to disclose the claimed “electrically conductive, substantially cylinder formed layer with mechanical dampening properties...located within an annular space defined by the outermost winding of the two windings; and...formed as a sandwich structure comprising at least two partial layers with a intermediate layer with mechanical dampening characteristics lying therebetween.” Combination of the Skinner and Moga references thus fails to render independent Claim 1 obvious, as well as those claims dependent therefrom. Applicants respectfully request reconsideration and withdrawal of this Section 103 rejection of independent Claim 1 and those claims dependent therefrom.

Dependent Claim 2

Dependent Claim 2 has been amended to clarify that “the electrically conductive layer is located in **the** annular space [defined by the outermost winding] located **between** the primary winding and the secondary winding, which **surrounds** the innermost winding of the two windings” (emphasis added).

The Park reference discloses, with reference to Figure 6, a shield 603 between primary input winding 604 and secondary output winding 602. But neither of the windings define an annular space there between, which includes an electrically conductive layer that surrounds the innermost winding, as set forth in dependent Claim 2. Further, the shield 603 of Park is to “help prevent any displacement current coupling between the input winding 604 and the output winding 602” (col. 5, lines 36-38), which teaches away from Applicants’ claimed electrically conductive layer.

Combination of Park with the Skinner and Moga references thus fails to render obvious dependent Claim 2. Applicants request reconsideration and withdrawal of the Section 103 rejection of Claim 2.

NEW CLAIMS

New Claims 12-20 have been added. The new claims are supported by the application as filed and do not present new subject matter.

New Claim 12, which is dependent on Claim 1, recites “wherein the intermediate layer of the electrically conductive layer is **different** than the two partial layers” (emphasis added). New Claim 13, which is dependent on Claim 12, recites “wherein the electrically conductive layer is **between** the primary winding and the secondary winding.” Support for Claims 12 and 13 can be found at, for example, Figures 2a, 2b,

and 3, as well as at page 5, lines 1-6. ***During the telephonic interview, the Examiner agreed that the features of Claims 12 and 13 are not anticipated by, or obvious in view of, the art of record.*** Applicants therefore respectfully request consideration and allowance of the new claims.

New independent Claim 14 recites, in part and with reference to Figures 2a, 2b, and 3, the following: “an electrically conductive layer [16] ***between*** the primary winding [1] and the secondary winding [3]” and including “an inner layer [16b]; an outer layer [16a]; and an intermediate layer [17] between the inner layer and the outer layer, the intermediate layer is ***different*** than the inner layer and the outer layer” (emphasis added). New independent Claim 18 recites, in part and with reference to Figures 2a, 2b, and 3, the following: “a cylindrical, electrically conductive layer [16] ***between*** the primary winding [1] and the secondary winding [3] in an annular space defined by the primary winding [1], the electrically conductive layer [16] including: an inner layer [16b]; an outer layer [16a]; and an intermediate layer [17] between the inner layer and the outer layer, the intermediate layer is ***different*** than the inner layer and the outer layer, and the intermediate layer includes mechanical dampening characteristics” (emphasis added). Support for Claims 14 and 18 can be found at, for example, Figures 2a and 2b, as well as at page 5, lines 1-6. ***During the telephonic interview, the Examiner agreed that at least these features of new independent Claims 14 and 18 are not anticipated by, or obvious in view of, the art of record.*** Applicants therefore respectfully request consideration and allowance of new independent Claims 14 and 18, as well as those claims dependent therefrom.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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